## REMARKS

The Office Action dated November 13, 2008, has been received and reviewed. Claims 29-31, 33-35 and 37-39 were pending in the application, of which claims 29-31, 33-35 and 37-39 are currently under examination. Claims 1-28, 32, 36 and 40 were previously canceled. No claim amendments have been made. No new matter has been added.

Applicant respectfully requests reconsideration of the application in light of the remarks below.

**Claim Rejections under 35 U.S.C. § 103**

Claims 29-31, 33-35 and 37-39 stand rejected as being unpatentable over U.S. Patent No. 6,515,975 to Chheda *et al.* ("Chheda") in view of U.S. Patent No. 5,898,682 to Kanai and further in view of U.S. Patent No. 6,567,682 to Moon. Applicant respectfully traverses this rejection, as hereinafter set forth.

To establish a *prima facie* case of obviousness the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974); *see also* MPEP § 2143.03. Additionally, the Examiner must determine whether there is "an apparent reason to combine the known elements in the fashion claimed by the patent at issue." *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1740-1741, 167 L.Ed.2d 705, 75 USLW 4289, 82 U.S.P.Q.2d 1385 (2007). Further, rejections on obviousness grounds "cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id* at 1741, quoting *In re Kahn*, 441, F.3d 977, 988 (Fed. Cir. 2006). Finally, to establish a *prima facie* case of obviousness there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Furthermore, the reason that would have prompted the combination and the reasonable expectation of success must be found in the prior art, common knowledge, or the nature of the problem itself, and not based on the Applicant's disclosure. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C. H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006); MPEP § 2144. Underlying the obvious determination is the fact that statutorily prohibited hindsight cannot be used. *KSR*, 127 S.Ct. at 1742; *DyStar*, 464 F.3d at 1367.

Applicant respectfully submits that the 35 U.S.C. § 103(a) obviousness rejections of claims 29-31, 33-35 and 37-39 are improper because the elements for a *prima facie* case of obviousness are not met. Specifically, the rejection fails to meet the criterion that the prior art references must teach or suggest all the claims limitations.

**Independent Claims 29, 33, 37**

Regarding independent claims 29, 33 and 37, Applicant's independent claims 29, 33 and 37 include claim limitations not taught or suggested in the cited references. Applicant's independent claims 29, 33 and 37, each recite, in part, "***detecting an unbalanced quality of power control signals*** from a wireless device simultaneously received at a plurality of base station transceivers involved in a soft handoff, ***wherein the unbalanced quality is determined based on qualities of power control signals from each of the plurality of base station transceivers involved in the soft handoff***," which is not taught or suggested in the cited references.

The Office Action states, in part:

> Regarding claim 29 ... Regarding claim 33 ... Regarding claim 37, ... ***Chheda*** et al. ***clearly show and disclose*** a method comprising ***detecting an unbalanced quality of power control signals*** from a wireless device simultaneously received at a plurality of base station transceivers involved in a soft handover, ***wherein the unbalanced quality is determined based on qualities of power control signals*** from each of the plurality of base station transceivers involved in the soft handoff (BTS sending forward link signals to MS and receiving power control channel signals; ***each of the BTSs sends the bit energy to noise density estimate and current transmit power to a central location such as BSC***; if any output powers incremental difference are found to exceed a predetermined threshold, these BTSs are instructed to use power output of the BTS(x) (the best) [col. 1 lines 15-28, col. 2 lines 37-28, col. 2 lines 37-53, ***col. 4 line 60-col. 5 line 33***]). (Office Action, pp. 2, 3, 5, 6, 8 and 9; emphasis added).

Applicant respectfully disagrees with this characterization of the teachings of Chheda. As stated, Applicant claims, *inter alia*, "***the unbalanced quality is determined based on qualities of power control signals from each of the plurality of base station transceivers involved in the soft handoff***," however, Chheda clearly teaches the 'unbalanced quality' is determined based on 'data qualities' of a "data frame." Specifically, Chheda teaches:

> ***[A]ll BTSs*** in a soft hand off mode with an MS ***estimate $E_b/N_o$ (bit energy to noise density), over a period "N". At present, a data frame is***

> ***generated over a time period of 20 ms (milliseconds) and thus comprises an appropriate time period for N.*** The process then continues with block 52 where each of the ***BTSs sends the $E_b/N_o$ estimate and current transmit power to a central location such as BSC*** 12 of FIG. 1. In a block 54, the ***BSC determines the "best BTS"*** which corresponds to BTS(x) ***having the best detected reverse link $E_b/N_o$.*** (Chheda, col. 5, lines 13-22; emphasis added).

Even assuming that Chheda teaches determining a "quality," Chheda's "quality" is ***based on*** an "***estimate $E_b/N_o$ (bit energy to noise density)*** ... [over] ***a data frame***" and **not** "***based on qualities of power control signals***" as claimed by Applicant. Furthermore, Chheda is entirely silent regarding *any* analysis of "qualities of [Chheda's] power control signals."

Regarding Kanai, the Office Action cites Kanai for allegedly teaching "increasing a target signal-to-noise ratio (SNR) of a pilot channel." (Office Action, pp. 3, 6 and 9).

Regarding Moon, the Office Action cites Moon for allegedly teaching "increasing a pilot channel transmit power level of the pilot channel transmitted by the wireless device during a handoff." (Office Action, pp. 4, 7 and 10).

Regardless of the veracity of the alleged teachings of Kanai and Moon, Applicant respectfully submits that neither Chheda nor Kanai nor Moon, either individually nor in any proper combination, teach or suggest Applicant's invention as presently claimed in independent claims 29, 33 and 37, which each recite, in part, "***detecting an unbalanced quality of power control signals*** from a wireless device simultaneously received at a plurality of base station transceivers involved in a soft handoff, ***wherein the unbalanced quality is determined based on qualities of power control signals from each of the plurality of base station transceivers involved in the soft handoff.***"

Therefore, since Chheda nor Kanai nor Moon fail to teach or suggest at least "***detecting an unbalanced quality of power control signals*** from a wireless device simultaneously received at a plurality of base station transceivers involved in a soft handoff, ***wherein the unbalanced quality is determined based on qualities of power control signals from each of the plurality of base station transceivers involved in the soft handoff***" as claimed by Applicant, Chheda, Kanai, and Moon, individually or in any proper combination, **cannot** render obvious, under 35 U.S.C. §103, Applicant's invention as presently claimed in independent claims 29, 33 and 37.

Accordingly, Applicant respectfully requests withdrawal of the rejection of independent claims 29, 33 and 37 based upon 5 U.S.C. §103.

**Dependent Claims 30, 31, 34, 35, 38 and 39**

The nonobviousness of independent claim 29 precludes a rejection of claims 30 and 31, which depend therefrom, because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See* In re Fine, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) obviousness rejection to independent claim 29 and claims 30 and 31 which depend therefrom.

The nonobviousness of independent claim 33 precludes a rejection of claims 34 and 35 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See* In re Fine, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) obviousness rejection to independent claim 33 and claims 34 and 35 which depend therefrom.

The nonobviousness of independent claim 37 precludes a rejection of claims 38 and 39 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See* In re Fine, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) obviousness rejection to independent claim 37 and claims 38 and 39 which depend therefrom.

**Finality of Next Office Action Precluded**

Applicant respectfully submits that the rejection of claims 29-31, 33-35 and 37-39 has been traversed by argument and not amendment. Therefore, **the finality of the next office action should be improper** as Applicant is entitled to an examination on the merits and to amend as a matter of right. In the present Office Action, Applicant's independent claims 29, 33 and 37 were not completely examined as to **all** of the elements. Accordingly, Applicant respectfully submits that this omission to examine all elements of Applicant's claimed invention constitutes a failure to articulate a *prima facie* case of unpatentability, and consequently the

burden to rebut this "rejection" has not yet shifted to the Applicant. Therefore, a next office action cannot properly be made final since only then would the Applicant be obligated to rebut the rejection, presuming that such office action sets forth a *prima facie* case. (MPEP § 706.07(a)).

## CONCLUSION

In light of the arguments contained herein, Applicant submits that the application is in condition for allowance, for which early action is requested.

Please charge any fees or overpayments that may be due with this response to Deposit Account No. 17-0026.

Respectfully submitted,

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